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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,736	05/01/2001	Dan Sanchez	155695-203	6102

7590

06/03/2003

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EXAMINER

SCHOPFER, KENNETH G

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 06/03/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary	Application No. 09/847,736	Applicant(s) SANCHEZ ET AL.	
	Examiner Kenneth G Schopfer	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 15-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn (USPN 5810712).

3. Referring to claims 1-4, Dunn teaches all of the limitations of these claims. Dunn teaches a medical system comprising:

- a) a pivot arm with first and second joints at 50;
- b) a ring 12 coupled to the joints; and
- c) an adapter 14 with an aperture for receiving a surgical instrument 52, which is supported by the ring and has a flange 40 adjacent to an inner lip of the ring.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn (USPN 5810712) in view of Wang et al. (USPN 5907664).

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6. Referring to claims 8-11, Dunn teaches all of the limitations of these claims except for the robotic arm that can move the surgical instrument. Dunn teaches a medical system comprising:

- a) a pivot arm with first and second joints at 50;
- b) a ring 12 coupled to the joints; and
- c) an adapter 14 with an aperture for receiving a surgical instrument 52, which is supported by the ring and has a flange 40 adjacent to an inner lip of the ring.

Wang et al. teach a medical system where a robotic arm is used to move a surgical instrument. It would have been obvious to one of ordinary skill in the art at the time of invention that a robotic arm as in Wang et al. could have been used with the medical system of Dunn in order to manipulate the surgical instrument during a procedure.

7. Claim 12-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn (USPN 5810712) in view of Wang et al. (USPN 5907664) as applied to claim 8 above, and further in view of Moore (USPN 4638799).

8. Referring to claims 12-14, the combined device of Dunn and Wang et al. teaches all of the limitations of this claim as described above except for the support arm assembly for supporting the pivot arm. Moore teaches a support assembly for a pivot arm having a table mount, an end effector coupled to the support arm and the pivot arm, and three pivotally connected linkages between the table mount and the end effector. It would have been obvious to one of ordinary skill in the art at the time of invention that the combined device of Dunn and Wang et al. could have included an assembly as in Moore in order to properly support a surgical instrument during a procedure.

Response to Arguments

9. Applicant's arguments filed March 12, 2003 have been fully considered but they are not persuasive. The applicant argues that the device of Dunn includes a fastener to hold the adapter on the ring, which distinguishes the device from the claims as amended. However, it is clear that portion 18 of the device of Dunn can be described as either integral to the ring or a ring itself that would not make the functionality of the device different from the claimed invention.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth G Schopfer whose telephone number is 703-305-2649. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

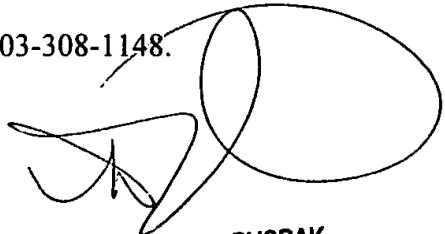
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

KS

KS
May 20, 2003



LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3700